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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,898	04/04/2002	Ian S. Williams	65961-0014	3859

10291 7590 09/14/2004

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EXAMINER	
MAYES, MELVIN C	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,898	WILLIAMS ET AL.	
	Examiner	Art Unit	
	Melvin Curtis Mayes	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 12/17/01.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

(1)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(2)

Claims 8-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 8 and 21, the phrase "panel-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "-like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim 21 recites the limitation "the inner surface of the outer layer" in line 7. There is insufficient antecedent basis for this limitation in the claim. There is no step of applying an outer layer on the mold surface before spraying the resin formulation

Claim 21 recites the limitation "the layered composite structure" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

(3)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(4)

Claims 1-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner, Jr. 5,885,662 in view of Taillefert et al. 4,810,452.

Gardner, Jr. discloses a method of making a panel structure to be mounted in an automotive vehicle as an instrument panel or door panel comprising: providing a mold; coating the mold surface with a microcrystalline wax mold releasing agent; spraying onto the mold surface an outer layer of water-dispersed composition of light stable thermoplastic polyurethane, coloring agent and suitable heat-activated crosslinker; applying sufficient heat to induce partial crosslinking of the polyurethane with the crosslinker; substantially drying the water-dispersed composition to obtain an opaque outer layer; spraying a resin composition of polyisocyanate, desirably aromatic, and at least one polyol onto the inner surface of the outer layer to form an inner layer, the inner layer crosslinked with the polyurethane of the outer layer via residual unreacted functional groups of the crosslinker to form a layered composite structure having interfacial chemical bonding between the outer layer and inner layer; and uniting the layered composite structure with a rigid substrate. The outer layer has a thickness of about 0.0025-0.0038 cm), the inner layer has a thickness of 0.10-0.15 cm and the polyol contains one or more pendent hydroxyl, carboxyl, or hydroxyl and carboxyl functional groups (col. 2-14). Gardner, Jr. does not disclose placing an ornament component on the mold surface before spraying the outer layer composition to form the outer layer integrated with the ornament component.

Taillefert et al. teach that in making a panel such as for the door of an automotive vehicle, the visible side of the panel is provided with effects by securing visible side

fragments of materials of differing natures such as moquette or fabric and/or of various colors and/or grains. Taillefert et al. teach that to remove the drawbacks of fastening such style effects onto the panel by adhesive bonding or sticking and make a panel by a method which is simple and economical, the panel is made by placing the fragments of ornamental material on a die of a mold before spraying a layer of polyurethane onto the die not covered by the fragments and onto at least a portion of the fragments to connect the fragments (col. 1-4).

It would have been obvious to one of ordinary skill in the art to have modified the method of Gardner, Jr. for making a door or instrument panel for an automotive vehicle by placing fragments of ornamental materials such as moquette or fabric or colors or grains (i.e. ornamental components) on the mold before spraying the outer layer polyurethane composition, as taught by Taillefert et al., to fasten ornamental materials onto a panel in a simple and economical method without the drawbacks of fastening such style effects onto a panel by adhesive bonding or sticking.

Providing the aromatic polyisocyanate of the resin composition as diphenylmethane diisocyanate and the crosslinker as a blocked diisocyanate such as hexamethylene diisocyanate, as claimed in Claims 11-13, would have been obvious to one of ordinary skill in art as aromatic polyisocyanate and crosslinker suitable for forming the layers of the panel.

(5)

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 8 above, and further in view of WO 98/57790.

Gardner, Jr. discloses providing the rigid substrate of any material possessing the requisite strength to reinforce and mount the outer layer and inner layer, such as thermoplastics.

WO 98/57790 teaches that in making an automotive interior panel-like structure having a rigid substrate, suitable rigid substrate is provided as polyolefin with reinforcement nanoparticles dispersed within the polyolefin, the nanoparticles providing benefits of: increased modulus of the substrate, improved surface toughness to reduce handling damage and improved thermal, mechanical and dimensional properties (pg. 22, lines 25-34, pg. 24, lines 11-17).

It would have been obvious to one of ordinary skill in the art to have modified the method of the references as combined by providing the rigid substrate as polyolefin with reinforcement nanoparticles, as taught by WO 98/57790, as a suitable rigid substrate for making an automotive interior panel-like structure, the nanoparticles present to provide the benefits of increased modulus of the substrate, improved surface toughness to reduce handling damage and improved thermal, mechanical and dimensional properties.

Double Patenting

(6)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(7)

Claims 1-17 and 19-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8-17 and 19 of U.S. Patent No. 6,544,449 in view of Taillefert et al. 4,810,452.

U.S. Patent No. 6,544,449 claims a process for making a layered composite structure comprising the steps as claimed. U.S. Patent No. 6,544,449 does not claim placing ornamental components on the mold surface before spraying the outer layer.

Taillefert et al. teach that in making a panel such as for the door of an automotive vehicle, the visible side of the panel is provided with effects by securing visible side fragments of materials of differing natures such as moquette or fabric and/or of various colors and/or grains. Taillefert et al. teach that to remove the drawbacks of fastening such style effects onto the panel by adhesive bonding or sticking and make a panel by a method which is simple and economical, the panel is made by placing the fragments of

ornamental material on a die of a mold before spraying a layer of polyurethane onto the die not covered by the fragments and onto at least a portion of the fragments to connect the fragments (col. 1-4).

It would have been obvious to one of ordinary skill in the art to have modified the method of U.S. Patent No. 6,544,449 for making a layered composite structure for a door or instrument panel by placing fragments of ornamental materials such as moquette or fabric or colors or grains (i.e. ornamental components) on the mold before spraying the outer layer polyurethane composition, as taught by Taillefert et al., to fasten ornamental materials onto a panel in a simple and economical method without the drawbacks of fastening such style effects onto a panel by adhesive bonding or sticking.

(8)

Claims 1-9, 15-17 and 19-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-9, 12 and 13 of U.S. Patent No. 6,013,210 in view of Taillefert et al. 4,810,452.

U.S. Patent No. 6,013,210 claims a process for making a panel structure comprising the steps as claimed. U.S. Patent No. 6,013,210 does not claim placing ornamental components on the mold surface before spraying the outer layer.

Taillefert et al. teach that in making a panel such as for the door of an automotive vehicle, the visible side of the panel is provided with effects by securing visible side fragments of materials of differing natures such as moquette or fabric and/or of various colors and/or grains. Taillefert et al. teach that to remove the drawbacks of fastening such style effects onto the panel by adhesive bonding or sticking and make a panel by a method which is simple and economical, the panel is made by placing the fragments of

ornamental material on a die of a mold before spraying a layer of polyurethane onto the die not covered by the fragments and onto at least a portion of the fragments to connect the fragments (col. 1-4).

It would have been obvious to one of ordinary skill in the art to have modified the method of U.S. Patent No. 6,013,210 for making a panel structure for a door or instrument panel by placing fragments of ornamental materials such as moquette or fabric or colors or grains (i.e. ornamental components) on the mold before spraying the outer layer polyurethane composition, as taught by Taillefert et al., to fasten ornamental materials onto a panel in a simple and economical method without the drawbacks of fastening such style effects onto a panel by adhesive bonding or sticking.

(9)

Claims 1-9, 15-17 and 19-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-9, 12 and 13 of U.S. Patent No. 5,885,662 in view of Taillefert et al. 4,810,452.

U.S. Patent No. 5,885,662 claims a process for making a panel structure comprising the steps as claimed. U.S. Patent No. 5,885,662 does not claim placing ornamental components on the mold surface before spraying the outer layer.

Taillefert et al. teach that in making a panel such as for the door of an automotive vehicle, the visible side of the panel is provided with effects by securing visible side fragments of materials of differing natures such as moquette or fabric and/or of various colors and/or grains. Taillefert et al. teach that to remove the drawbacks of fastening such style effects onto the panel by adhesive bonding or sticking and make a panel by a method which is simple and economical, the panel is made by placing the fragments of

ornamental material on a die of a mold before spraying a layer of polyurethane onto the die not covered by the fragments and onto at least a portion of the fragments to connect the fragments (col. 1-4).

It would have been obvious to one of ordinary skill in the art to have modified the method of U.S. Patent No. 5,885,662 for making a panel structure for a door or instrument panel by placing fragments of ornamental materials such as moquette or fabric or colors or grains (i.e. ornamental components) on the mold before spraying the outer layer polyurethane composition, as taught by Taillefert et al., to fasten ornamental materials onto a panel in a simple and economical method without the drawbacks of fastening such style effects onto a panel by adhesive bonding or sticking.

Conclusion

(10)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morrison et al. disclose providing panels with inserts by positioning the inserts in a mold and a spraying plastic into the mold.

JP 2-145310 discloses providing an automotive pad skin with decorative articles or ornaments by placing the ornaments on a mold and spraying resin on the mold to adhere the ornaments to the skin at the same time as forming the skin.

(11)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM
September 9, 2004